

Application No.: 10/717,290

REMARKS

Claims 24-46 are pending in the Application. Claims 24 and 41 are currently amended.

Rejection under 35 U.S.C. §112

The Examiner has rejected claims 1, 30, and 36-42 under 35 U.S.C. §112, second paragraph as being indefinite. As Claim 1 was canceled in the Preliminary Amendment filed in the Application on January 25, 2005, Applicants believe that the Examiner meant to reject Claim 24 instead of Claim 1. Applicants have amended Claims 24 and 41 in accordance with the Examiner's suggestions. In view of the amendments, Applicants believe that the rejection under this section has been overcome. Applicants thank the Examiner for her suggested amendments.

Double Patenting Rejection

The Examiner has rejected Claims 24-42 under the judicially created doctrine of obviousness-type double patenting over claims 1-9 of U.S. Patent No. 6,645,941 (the '941 patent). The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compounds are encompassed by the patented compounds. Applicants disagree and respectfully submit that the rejection is not appropriate.

U.S. Patent Number 6,645,941 claims azalide derivatives possessing a substituted or unsubstituted nitrogen moiety at the 9a position of the macrolide as represented by "D" in Claim 1-9 of '941 patent. The presently claimed invention does not claim an azalide derivative having a nitrogen moiety at the 9a position. The presently claimed species does not even include a 9a position on the macrolide ring. Therefore, present claims 24-46 are not encompassed by the claims of the '941 patent nor are they obvious variations of the claims of the '941 patent. Applicants respectfully request the withdrawal of this rejection.

Terminal Disclaimer:

Applicants are filing herewith a terminal disclaimer over U.S. Patent Number 6,878,691, a parent of the present application.

Application No.: 10/717,290

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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Page 10 of 10